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09/933,683	08/20/2001	Michelle A. Butler	10003.001800 (digeo 114)	6383
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DIGEO, INC C/O STOEL RIVES LLP 201 SOUTH MAIN STREET, SUITE 1100 ONE UTAH CENTER SALT LAKE CITY, UT 84111			CHANG, SHIRLEY	
			ART UNIT	PAPER NUMBER
			2623	

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/933,683		<b>Applicant(s)</b> BUTLER ET AL.	
	<b>Examiner</b> Shirley Chang		<b>Art Unit</b> 2623	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 24 January 2006.

2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-49 is/are pending in the application.

4a) Of the above claim(s) 1-21, 33-45, 46-47, 49 is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 22-31, 34-43 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____. 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____.
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## **DETAILED ACTION**

### **Note to Applicant**

Art Units 2611, 2614 and 2617 have changed to 2623. Please make all future correspondence indicate the new designation 2623.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-21 drawn to a system for sensing the presence of an object near the display to determine selection of an object, classified in class 725, subclass 10.
- II. Claims 22-31, 34-43, drawn to a method for receiving and displaying text and narration with payment for access of an electronic program, classified in class 725, subclass 25.
- III. Claims 33, 45, drawn to a touch screen showing the meaning of a word corresponding to a location of the touch, classified in class 725, subclass 37.
- IV. Claims 46-47, 49, drawn to a device having a touch sensitive input in communication unit that duplicates the image on a display, classified in class 725, subclass 133.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in

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scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as charging a rental fee; subcombination II has separate utility such as touch screen showing the meaning of a word on a building display; subcombination III has separate utility such as touch sensitive input in communication that duplicates image on a cell phone display. See MPEP § 806.05(d).

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Kory Christensen on 3/27/06 a provisional election was made without traverse to prosecute the invention of II, claims 22-31, 34-43. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-21, 33, 45-47, and 49 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### **Response to Arguments**

Applicant's arguments with respect to claims 22 and 34 have been considered but are moot in view of the new ground(s) of rejection.

a. Applicant argues on page 20, first paragraph that Bulman does not specifically disclose the steps of claim 22 in 'interactive format.'

Bulman indeed discloses 'interactive format' since the system is highly customizable to such things as a user's name, intonation, and photograph. Bulman discloses: a method in a computer system, comprising: receiving electronic information in an interactive format via a television system; ("superimposed images, so generated, are supplied to a digital-to-analog converter which converts the image to a single frame in NTSC format" col. 11, lines 1-5); displaying said electronic information, including text from said electronic information, for viewing by a viewer ("FIG. 7 depicts an image frame in which the head of a human subject has been superimposed upon the body shown in FIG. 6" col. 8, lines 41-44]); and providing a narration of said text substantially contemporaneously with displaying said text ("For example, a close-captioned signal may be included with the audio text" col. 13, lines 17-21; fig. 8); accepting input other than payment information from said viewer (the name of a human subject is spoken into the microphone col. 11, lines 24-31); and modifying said electronic information based on said input, thereby adapting a result of performing the providing step (the name is inserted at the predetermined point in the story. It will be naturally spoken in the context of the sentences in which it appears; col. 11, lines 24-31; col. 12, lines 26-50).

b. Applicant argues on page 20, second paragraph that Bulman does not specifically disclose 'a plurality of fields' in the 'electronic information' wherein 'at least one of a plurality of fields is disposed to receive values for identifying characteristics about a viewer.'

Bulman discloses a 'a plurality of fields' in the 'electronic information' wherein 'at least one of a plurality of fields is disposed to receive values for identifying characteristics about a viewer' ("Personal names, e.g., "JASON", with a proper intonation, are inserted in this audio data stream on the fly. If the name is to be added at the end of a sentence, digital representations thereof are added "flush left", i.e., with a variable length sound gap between the end of the sentence and the beginning of the next sentence; if it is to be inserted at the beginning of a sentence, the digital representations are added "flush right", i.e., with a variable length gap before the name, so that the sentence will sound "natural" in reproduction. The name may also be embedded in the sentence, with variable length gaps at pauses within or at the beginning and/or end of the sentence" col. 11, lines 38-52).

c. Applicant argues on page 20, second paragraph that Bulman does not specifically disclose 'taking a picture...' and 'inserting said picture...'

Bulman indeed discloses taking a picture of a child viewing the electronic information being displayed ("FIG. 2 illustrates how the head of a human subject can be

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scanned by an electronic scanner to form stored images. In this case, a video camera 14 is arranged to view the head 16 of the human subject. This human subject stands on a platform 18 which is rotated about a vertical axis 20. In this way, a plurality of video flames are obtained, each containing the image of the head 16 in a different angular position. These video flames are stored on a video cassette recorder (VCR) 24. The stored video flames may be thereafter digitized, in an analog-to-digital converter, to provide digital representations of each frame" col. 9, lines 17-27); inserting said picture into a story line within said electronic information being displayed ("The presentation ("story") is now recorded from the hard drive of the PC workstation to a videotape (or other possible media in the future). The story consists of a sequence of video and audio elements (images, voice messages, music) that are played in a predetermined order to create the story. In that sequence, the background images with the superimposed heads will appear in their predetermined places to create a personalized videotape" col. 12, lines 30-39).

### **Claim Rejections - 35 U.S.C. § 103**

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**1. Claims 22-25, and 34-37 are rejected under 35 U.S.C. § 103(e) as being unpatentable over Bulman et al. (2003/0051255) in view of Hornbuckle (5388211).**

As to claims 22 and 34,

Bulman et al. discloses:

a method in a computer system, comprising: receiving electronic information in an interactive format via a television system; ("superimposed images, so generated, are supplied to a digital-to-analog converter which converts the image to a single frame in NTSC format" col. 11, lines 1-5);

displaying said electronic information, including text from said electronic information, for viewing by a viewer ("FIG. 7 depicts an image frame in which the head



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of a human subject has been superimposed upon the body shown in FIG. 6" col. 8, lines 41-44)); and

providing a narration of said text substantially contemporaneously with displaying said text ("For example, a close-captioned signal may be included with the audio text" col. 13, lines 17-21; fig. 8);

accepting input other than payment information from said viewer (the name of a human subject is spoken into the microphone col. 11, lines 24-31); and

modifying said electronic information based on said input, thereby adapting a result of performing the providing step (the name is inserted at the predetermined point in the story. It will be naturally spoken in the context of the sentences in which it appears; col. 11, lines 24-31; col. 12, lines 26-50).

Bulman fails to specifically teach "receiving payment information for accessing said electronic information; wherein said payment comprises a rental charge for accessing said electronic information."

In an analogous art, Hornbuckle discloses a system with the usage of rental software col. 5, lines 28-40).

It would have been obvious to one of ordinary skill in the art to modify Bulman system to teach 'receiving payment information for accessing said electronic information; wherein said payment comprises a rental charge for accessing said

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electronic information', as taught by Hornbuckle, so as to allow allowing 'rental software to be run whenever and as often as the user desires, and to further allow the user to take advantage of the software based functionality of Bulman without having to purchase a copy.

As to claims 23 and 35, Bulman et al. discloses:

wherein said electronic information comprises at least one of a plurality of fields; wherein said at least one of a plurality of fields is disposed to receive values for identifying characteristics about a viewer ("Personal names, e.g., "JASON", with a proper intonation, are inserted in this audio data stream on the fly. If the name is to be added at the end of a sentence, digital representations thereof are added "flush left", i.e., with a variable length sound gap between the end of the sentence and the beginning of the next sentence; if it is to be inserted at the beginning of a sentence, the digital representations are added "flush right", i.e., with a variable length gap before the name, so that the sentence will sound "natural" in reproduction. The name may also be embedded in the sentence, with variable length gaps at pauses within or at the beginning and/or end of the sentence" col. 11, lines 38-52).

As to claim 24 and 36, Bulman et al. discloses:

wherein said method further comprises: populating at least one of said plurality of fields with a name of a child viewing the electronic information being displayed (met as discussed in claim 23).

As to claims 25 and 37, Bulman et al. discloses:

taking a picture of a child viewing the electronic information being displayed (FIG. 2 illustrates how the head of a human subject can be scanned by an electronic scanner to form stored images. In this case, a video camera 14 is arranged to view the head 16 of the human subject. This human subject stands on a platform 18 which is rotated about a vertical axis 20. In this way, a plurality of video flames are obtained, each containing the image of the head 16 in a different angular position. These video flames are stored on a video cassette recorder (VCR) 24. The stored video flames may be thereafter digitized, in an analog-to-digital converter, to provide digital representations of each frame" col. 9, lines 17-27);

inserting said picture into a story line within said electronic information being displayed ("The presentation ("story") is now recorded from the hard drive of the PC workstation to a videotape (or other possible media in the future). The story consists of a sequence of video and audio elements (images, voice messages, music) that are played in a predetermined order to create the story. In that sequence, the background images with the superimposed heads will appear in their predetermined places to create a personalized videotape" col. 12, lines 30-39).

**2. Claims 28-31 and 40-43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bulman et al. (2003/0051255) in view of Hornbuckle (5388211), in further view of Lee (2001/0037510).**

As to claims 28 and 40,

Although Bulman et al. does not specifically disclose “receiving at least one of a plurality of foreign language audio programs via an IP channel; receiving from a viewer a selection of a language of choice; and receiving both an audio program and said text in said language of choice,” Lee teaches: receiving at least one of a plurality of foreign language audio programs via an IP channel ([0037], “character information to be translated can comprise audio information synchronized with itself” [0038], S36, fig. 3A); receiving from a viewer a selection of a language of choice (S31, fig. 3A); receiving both an audio program and said text in said language of choice ([0039], [0039], and [0036]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify Bulman et al. with Lee with the claimed limitations, so as to “satisfy a desire of a user, and improve a convenience of a user” [0052].

As to claims 29 and 41, Lee discloses:

selecting audio and text overlays based upon said selection of a language of choice (S31, fig. 3A;). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify Bulman et al. with Lee with the claimed limitations, so as to “satisfy a desire of a user, and improve a convenience of a user” [0052].

As to claims 30 and 42, Lee discloses:

tuning said television by receiving a selection made from at least one of a plurality of on-screen choices (the television tunes the channel selected from the EPG [0011]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify Bulman et al. with Lee with the claimed limitations, so as to "satisfy a desire of a user, and improve a convenience of a user" [0052].

As to claims 31 and 43, Lee discloses:

selecting text in an on-screen overlay based upon said selection of a language of choice (met as discussed in claim 28).

**3. Claims 26, 27, 38, and 39 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bulman et al. (2003/0051255), in view of Hornbuckle (5388211), in further view of Safadi et al. (2001/0051037), and in further view of Best (4305131).**

As to claims 26 and 38,

Although Bulman does not specifically disclose: "presenting a problem to be solved in an interactive program content delivered by a Personal Video Recorder (PVR); pausing said interactive program content to go into interactive mode; determining an answer to said problem presented; receiving an input comprising a touch of a selected answer," Safadi teaches: "The basic concept of the VCR has recently been extended to

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digital compression devices that provide even more features for managing the reception and recording of audiovisual programming. These products have a number of names such as personal television products, personal versatile recorders, video recording computers, personal television servers, and the like, referred to hereinafter as "personal versatile recorders" (PVR)" [0008]. Therefore, it would have been clearly obvious to one of ordinary skill in the art at the time the invention was made to modify Bulman to utilize a PVR, so as to extend the basic concept of the VCR to provide even more features for managing the reception and recording of audiovisual programming [0008].

Furthermore, although the combination of Bulman and Safadi do not specifically disclose "presenting a problem to be solved in an interactive program content delivered by a Personal Video Recorder (PVR); pausing said interactive program content to go into interactive mode; determining an answer to said problem presented; receiving an input comprising a touch of a selected answer," Best teaches:

presenting a problem to be solved in an interactive program content delivered by a Personal Video Recorder (PVR) (col. 9, lines 58-68; "fig. 10", wherein the 'problem' is "We're outnumbered! Do we fight or run?");

pausing said interactive program content to go into interactive mode ("Such an actor, shown on the screen in FIG. 10 and called a "helper" in FIG. 11 block 461, is the player's alter ego in the movie and keeps the player(s) informed on what is happening, what problems require a decision, and what the options are" col. 9, line 58 to col. 10, lines 1-6; since a decision is "required," the procedure will not proceed without a decision, and hence the program is effectively 'paused.');

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determining an answer to said problem presented (fig. 10, wherein user chooses 'run');

receiving an input comprising a touch of a selected answer (fig. 10, user uses the hand held device to input answer which will be received by the system, shown in fig. 13).

Therefore, it would have been clearly obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Bulman and Safadi to include the claimed limitations, as taught by Best, so as to "increase the realism of the illusion that the player is a personal participant" col. 11, lines 17-49.

As to claims 27 and 39, Best teaches:

embedding into a broadcast program content at least one of a plurality of triggers to cause a PVR to pause program (the branch points of fig. 11 are effectively 'triggers', which are part of the television movie, or "broadcast program");

allowing a viewer to interact with said program at own pace (fig. 11 and as discussed in claim 26, since the viewer decides which decisions to choose at his own pace);

continuing to a subsequent part of said program (fig. 11 and as discussed in claim 26).

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shirley Chang whose telephone number is (571) 272-8546. The examiner can normally be reached on 8:30-5:00 M-F.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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